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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,296	03/20/2001	Ted R. Rittmaster	GTUS03	2288

7590 04/02/2009
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EXAMINER

LE, KHANH H

ART UNIT	PAPER NUMBER
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3688

MAIL DATE	DELIVERY MODE
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04/02/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/812,296	Applicant(s) RITTMASER ET AL.	
	Examiner KHANH H. LE	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05/15/2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2006-01-03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responsive to the correspondence filed 12/11/2008. Claims 1, 8, 19-39 were pending and all cancelled. New claims 40-57 are added. Thus claims 40-57 are pending. Claims 40 and 49 are independent.

Drawings

2. The amended drawings filed May 05/15/2006 are acceptable and have been entered.

Claim Objections

3. **Claims 49-57 are objected to because of the following informalities:**
 - a. Claim 49, next to last line: it is not clear how information can be "partial access but not full access" since information cannot be access. Inserting "information" after "full access" would overcome the objection
 - b. Claims 50-57 are rejected as being dependent upon rejected base claim 49. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. **Claims 40-57 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

a. Claim 40:

Relevant specification paragraphs to this issue of new matter are: [0058] (determining region X) and [0059] (determining region y) read together with [0055]; [0056].

Claim 40 reads:

*"...requiring predefined additional information before providing the given recipient processor with access to first information in the event that the given recipient processor is determined to be within the predefined location or region; and
predefined "additional information; and (2) claim 40 further includes a step of
"providing the given recipient processor with access to first information without requiring the predefined additional information in the event that the given recipient processor is not determined to be within the predefined location or region."*

Applicant argues that claim 40 is supported by the original application, including original claim 1 and paragraphs [0058] and [0059].

Interpretation of claim 40 in view of specification [0059] read together with [0058]:

[0059] read together with [0058] may fairly be read as disclosing: regions X, Y, Z wherein inside region X, full access information with (or without) "predefined" additional information is provided; inside region Y (i.e. outside X) partial access information is provided with (per [0059]) (or without, per [0058]) predefined additional information; and no access to any information for user devices (such as 16) located outside of regions X and Y (per [0058]).

Per [0059], "first information" of claim 40 can be full (or partial) access information.

i. Assuming "first information" of claim 40 is full access information, claim 40 would be interpreted, as:

inside a region(e.g. X per [0059]), full access information with" predefined" additional information is provided; and outside region X (e.g. inside region Y per [0059]), full access information (first information) is provided without "predefined" additional information.

However [0059] read together with [0058] only satisfies the 1st prong of claim 40 (i.e. full access information is provided inside region X with requiring additional information) but not the second prong of claim 40 (i.e. outside region X (e.g. inside region Y per [0059]), full access information (first information) provided without "additional information). This is because as shown above, [0059] read together with [0058], at best, can disclose, in region Y outside of X,

partial access without additional information, but surely does not disclose full access without predefined additional information as required in the second prong of claim 40.

Moreover nothing in [0059] read together with [0058] discloses the particular combination of within a region (e.g. X) full access information with predefined additional information and outside the region, full access information without predefined additional information as required by claim 40.

ii. The same analysis applies if "first information" in claim 40 is interpreted as partial access information. Claim 40 would then be interpreted as: inside a region (e.g. Y, per [0059]) partial access information with "predefined" additional information is provided; then outside region Y (e.g. inside region X, per [0059]), partial access information without "predefined" additional information would be provided.

However [0059] read together with [0058] again only satisfies the 1st prong of claim 40 (i.e. inside region Y (i.e. outside X) partial access information with additional information) but not the second prong of claim 40 (i.e. outside region Y (i.e. inside region X) partial access information without "predefined" additional information. This is because as shown above, [0059] read with [0058], only talks about full access not partial access inside region X).

Moreover nothing in [0059] read together with [0058] discloses the particular combination of within a region (e.g. Y) partial access information is provided with predefined additional information and outside the region (i.e. Y), partial access information without predefined additional information.

Thus claim 40 is not inherent from [0059] read together with [0058], or any other part of the specification thus it is new matter.

Claims 41-48 are rejected as being dependent upon rejected base claim 40.

b. Claim 49:

Claim 49 claims:

"...requiring predefined additional information before providing the given recipient processor with access to first information in the event that the given recipient processor is determined to be within the predefined location or region; and

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providing the given recipient processor with access to second information without requiring the predefined additional information in the event that the given recipient processor is not determined to be within the predefined location or region, wherein the one of the first and second information is a partial access but not full access to a product or service and the other of the first and second information is full access to the product or service."

Applicant argues that claim 49 is supported by the original application, including original claim 1 and paragraphs [0058] and [0059].

Interpretation of claim 49 in view of specification [0059] read together with [0058]:

Per [0059], first information and "second information can be full (or partial access) information. Claim 49 means that if " first information" is full access information then "second information" is partial access information and vice versa.

[0059] read together with [0058] may fairly be read as disclosing: regions X, Y, Z wherein inside region X, full access information with (or without) "predefined" additional information may be provided; inside region Y (i.e. outside X) partial access information with (or without) predefined additional information may be provided;" and no access for user devices (such as 16) located outside of regions X and Y" (per [0058]).

i. Assuming " first information" of claim 49 is full access information (i.e. " second information" is partial access), claim 49 is interpreted in view to the specification as:
inside a region (e.g. X), full access information is provided with predefined additional information; then inside region Y (outside region X) partial access is provided without "predefined" additional information.

However [0059] read together with [0058] does not fairly disclose that. That is because [0059] read together with [0058], may only be fairly read as disclosing:

full access information may be provided inside region X with predetermined additional information , and outside X, (i.e. inside region Y) it may be provided partial access information with (per [0059]) or without (per [0058]) "predefined" additional information;

but not necessarily disclosing the particular combination of when inside region X, full access information with predefined additional information is provided ; then outside region X (inside region Y) partial access without “predefined” additional information is provided.

ii. Likewise, assuming” first information” of claim 49 is partial access information (i.e. “ second information” is full access information) claim 49 is interpreted, in view of the specification, as: inside region Y, partial access information with predefined additional information; then inside region X (outside region Y) full access information without “predefined” additional information;

However [0059] read together with [0058] does not fairly disclose that. That is because [0059] read together with [0058], may only be fairly read as disclosing, as stated above, full access information may be provided inside region X without predetermined additional information , and outside X, (i.e. inside region Y) it may be provided partial access information with ”predefined” additional information [0059]; but not necessarily the particular combination of when inside region Y, partial access information with predefined additional information is provided then outside region Y (e.g. in region X) full access information without “predefined” additional information is provided.

Thus claim 49 is not inherent from [0059] read together with [0058], or any other part of the specification, thus it is new matter.

Claims 50-57 are rejected as being dependent upon rejected base claim 49.

Response to Arguments

6. Applicant's arguments filed 12/11/2008 have been fully considered but they are not persuasive.

a. As stated by Applicants, claim 40 corresponds to original claim 1, but with the following changes: (1) the step of requiring additional information from original claim 1 is recited in claim 40 as requiring "predefined" additional information; and (2) claim 40 further includes a step of "providing the given recipient processor with access to first information without requiring the predefined additional information in the event that the given recipient processor is not determined to be within the predefined location or region."

New claim 49 also corresponds to original claim 1, but with the following changes: (1) the step of requiring additional information from original claim 1 is recited in claim 40 as requiring "predefined" additional information; and (2) claim 49 further includes a step of "providing the given recipient processor with access to second information without requiring the predefined additional information in the event that the given recipient processor is not determined to be within the predefined location or region, wherein the one of the first and second information is a partial access but not full access to a product or service and the other of the first and second information is full access to the product or service." (underline emphasis added).

Method claims 40 and 49 claim in the alternative: the providing step in both claims 40 and 49 is a contingent step due to the recitation "in the event of". It is interpreted the first alternative occurs (i.e. the given recipient processor is determined to be within the predefined location or region), not the alternative event, thus the "providing..without requiring predetermined additional information" step does not occur, thus needs not be considered. **Thus claims 40 and 49 are interpreted as claim 1 was previously, thus the previous rejections based on prior art as applied to original claim 1 are maintained and apply to claims 40 and 49. Their dependent claims are similar to original claims 2-9 and thus are similarly rejected.**

b. **Applicants further argue that the instant application predates Fano (Response p. 10).** However the instant application presently does not have the benefit of prior-filed application 09/052,746 filed on 03/31/1998 (now U.S. Patent No. 6,154,172) because if applicant desires to claim the benefit of a prior-filed application under 35 U.S.C. 120, a specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) must be included in the first sentence(s) of the specification following the title or in an application data sheet. For benefit claims under 35 U.S.C. 120, 121 or 365(c), the reference must include the relationship (i.e., continuation, divisional, or continuation-in-part) of the applications.

(Note: If the instant application is a utility or plant application filed under 35 U.S.C. 111(a) on or after November 29, 2000, **the specific reference must be submitted during the pendency of the application and within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application.** If the application is a utility or plant application which entered the national stage from an international

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application filed on or after November 29, 2000, after compliance with 35 U.S.C. 371, the specific reference must be submitted during the pendency of the application and within the later of four months from the date on which the national stage commenced under 35 U.S.C. 371(b) or (f) or sixteen months from the filing date of the prior application. See 37 CFR 1.78(a)(2)(ii) and (a)(5)(ii). **This time period is not extendable and a failure to submit the reference required by 35 U.S.C. 119(e) and/or 120, where applicable, within this time period is considered a waiver of any benefit of such prior application(s) under 35 U.S.C. 119(e), 120, 121 and 365(c). A benefit claim filed after the required time period may be accepted if it is accompanied by a grantable petition to accept an unintentionally delayed benefit claim under 35 U.S.C. 119(e), 120, 121 and 365(c).** The petition must be accompanied by (1) the reference required by 35 U.S.C. 120 or 119(e) and 37 CFR 1.78(a)(2) or (a)(5) to the prior application (unless previously submitted), (2) a surcharge under 37 CFR 1.17(t), and (3) a statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(2) or (a)(5) and the date the claim was filed was unintentional. The Director may require additional information where there is a question whether the delay was unintentional. The petition should be addressed to: Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

If the reference to the prior application was previously submitted within the time period set forth in 37 CFR 1.78(a), but not in the first sentence(s) of the specification or an application data sheet (ADS) as required by 37 CFR 1.78(a) (e.g., if the reference was submitted in an oath or declaration or the application transmittal letter), and the information concerning the benefit claim was recognized by the Office as shown by its inclusion on the first filing receipt, the petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) are not required. Applicant is still required to submit the reference in compliance with 37 CFR 1.78(a) by filing an amendment to the first sentence(s) of the specification or an ADS. See MPEP § 201.11.)

Here, such specific reference to the prior filed application including the relationship (i.e., continuation, divisional, or continuation-in-part) is lacking and the later of four months from the actual filing date of the instant application (filing date was March 20, 2001) or sixteen months from the filing date of the prior application (09/052,746 was filed on 03/31/1998) has passed. Thus **a petition needs to be granted to claim priority**. Also the instant Oath or Declaration

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claims priority from provisional application 60191003, filed 03/21/2000, but does not mention prior application 09/052,746.

It is acknowledged the Specification at page 1, states: “*Related Applications*
The present invention relates to United States Provisional Application 60/191,003, filed March 21, 2000, which is incorporated herein by reference and from which priority is claimed. The present invention also relates to U.S. Patent No. 6,154,172, issued November 28, 2000 and PCT Application No. PCT/US99/06943, filed March 30, 1999, each of which is incorporated herein by reference.”

However mere incorporation by reference does not confer benefit of a prior-filed application when the specific reference to the prior-filed application in compliance with 37 CFR 1.78(a) has not been satisfied. See MPEP § 201.11.

c. **Further, the burden of establishing prior inventorship is on applicant and must be done by way of an affidavit under rule 131.** (37 C.F.R. § 1.131 requires that the showing be done in affidavit format; has the proper formalities and be signed by the full inventive entity. See MPEP 715.04. No affidavit or declaration has been submitted. Therefore, the rejection stands.

Applicant argues constructive reduction to practice (Response p. 10, last 4 lines).
The Examiner notes the text of 37 C.F.R. § 1.131 (b) (see below, bold emphasis added) seems to require showing of actual reduction to practice not just constructive reduction to practice. The Examiner also notes that, in the text of 37 C.F.R. § 1.131, (if constructive reduction to practice were to be argued) the date of “filing of the (i.e. instant) application” is important. It is believed case law has extended this to allow for effective filing date of the application (giving credit for 119 and 120 benefit if the claim is fully supported). However, since Applicant does not have the benefit of priority under 35 U.S.C. 119, 120 or 121 (until a properly filed petition is granted), the filing date of 03/31/1998 (for 09/052,746, now U.S. Patent No. 6,154,172) is not the filing date of the (instant) application.

“37 C.F.R. § 1.131 (Affidavit or declaration of prior invention) :

(a) When any claim of an application or a patent under reexamination is rejected, the inventor of the subject matter of the rejected claim, the owner of the patent under reexamination, or the party qualified under §§ 1.42, 1.43, or 1.47, may submit an appropriate oath or declaration to establish invention of the subject matter of the

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rejected claim prior to the effective date of the reference or activity on which the rejection is based. The effective date of a U.S. patent, U.S. patent application publication, or international application publication under PCT Article 21(2) is the earlier of its publication date or date that it is effective as a reference under 35 U.S.C. 102(e). ...

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from prior to said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence must be satisfactorily explained."

Applicants are encouraged to consult Ex Parte Schatz et al., USPTO Board of Patent Appeals and Interferences # 2007-1355 (Application SN 10/449,558) decided Sep 21, 2007, holding that an application not in the benefit chain cannot be relied on for constructive reduction to practice. This is a not binding precedent decision but the reasoning may be informative. Without the benefit of 35 U.S.C. 120, at best 09/052,746, now U.S. Patent No. 6,154,172 (if 35 U.S.C. 112 is satisfied) is evidence of conception, not of due diligence, from prior to the effective date of the reference, to the filing of the (instant) application) as required by 37 C.F.R. § 1.131.

d. The Examiner also notes the evidence submitted in the affidavit should clearly be explained to overcome the prior art as applied to each claim. (Just citing the 09/052,746, now U.S. Patent No. 6,154,172 is not sufficient proof of actual reduction showings. Mapping of the 09/052,746 specifications to the claims may be needed.). See e.g. MPEP 715.07, part excerpted below:

"..The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred.")."

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 40-41, 45-47, 49-50 and 54-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Fano, US 6317718 B1, herein Fano.

Fano discloses:

“An agent based system utilizes a Personal Digital Assistant (PDA)-based, Global Positioning System (GPS)-enabled information gathering agent to create a customized offer information summary based on the location of a user and one or more items of interest. One or more items of interest are obtained from a user. The physical location of the user is determined. A query based on the items of interest and the physical location of the user is then created. A network of information is queried utilizing this query. A customized offer is received from a retailer-based agent in response to the query. The customized offer information associated with the items of interest and their locations relative to the physical location of the user is displayed.” (Abstract).

Thus, as to claims 40 and 49, Fano discloses

A method for controlling the distribution of information from an information provider processor to a plurality of recipient processors on a communications network, based on the geographic locations of the recipient processors the method comprising:

associating a respective positioning system with each respective recipient processor (see at least abstract; col. 47 lines 20-40; Figs. 24-27 and associated text)

receiving location information from the positioning system associated with a given recipient processor, the location information corresponding to the general geographic location of the given recipient processor (see at least abstract; col. 47 lines 20-40; Fig. 27 and associated text);

determining, from the location information, whether the geographic location of the given recipient processor is within a predefined location or region (see at least abstract; col. 47 lines 20-40: the user is determined to be within the mall or not);

requiring predefined additional information (implicitly at least the user device ID, which is inherently predefined, is requested by the system for customized suggestions, see at least col. 47 lines 40-66);

before providing the given recipient processor with access to first information (see at least col. 47 lines 61-65: customized suggestions) in the event that the given recipient processor is determined to be within the predefined location or region.

As to claims 41 and 50, Fano implicitly discloses wherein requiring additional information comprises communicating a query from the provider processor to the given recipient processor for the additional information (implicitly at least the user device ID is requested by the system for customized suggestions, see at least col. 47 lines 40-66).

As to claims 45 and 54, Fano discloses the methods of claims 40 and 49 and further discloses the additional information comprises current time information (see at least col. 38 lines 54-57).

As to claims 46 and 55 , Fano discloses the methods of claims 40 and 49 and further discloses wherein the additional information comprises user identification information (implicitly at least the user device ID is requested by the system for customized suggestions, see at least col. 47 lines 40-66);

As to claims 47 and 56 , Fano discloses the methods of claims 40 and 49 and further discloses wherein receiving location information comprises receiving location information over the network by the provider processor and determining comprises determining, by the provider processor, (see at least Figs. 24-25 and associated text: “intelligent agents coordinators” , item 2580 of the back end servers 2400 in Fig 25 determine location information of the user devices; see also col. 38 lines 54-57), whether the geographic location of the given recipient processor is within a predefined location or region (e.g., col. 47 lines 20-40: the user is determined to be within the mall or not).

9. Claims 40 and 49 are alternatively rejected and claims 48 and 57 are rejected under 35 U.S.C. 102(e) as being anticipated by Cohen, US 6236330 B1, herein Cohen.

Cohen discloses:

“ A mobile display system comprises one or more movable billboard displays, equipped with externally viewable display panels and a controller. The display is moved from location zone to location zone by a transporter which may comprise a person or a vehicle. The controller ascertains the display location and drives the display to generate a publicly viewable message selected for viewing within such location zone. The message is displayed pursuant to a schedule which includes date, time of day and display duration while the display is within the zone or until the display is located in another zone which is not included within the message schedule. A tiered system control network includes a plurality of fixed stations which transmit message content and scheduling data to the controller and which generate billing and other accounting records. An advertiser may communicate with the network for creating and changing message content and scheduling data.” (abstract).

Thus as to claims 40 and 49, Cohen discloses:

A method for controlling the distribution of information from an information provider processor to a plurality of recipient processors on a communications network, based on the geographic locations of the recipient processors the method comprising:

associating a respective positioning system with each respective recipient processor (see at least Figs. 1-4 and associated text; col.1 line 60 to col. 2 line18; col. 3 line 43 to col. 5 line 67) ;

receiving location information from the positioning system associated with a given recipient processor, the location information corresponding to the general geographic location of the given recipient processor (see at least Figs. 1-4 and associated text; col.1 line 60 to col. 2 line18; col. 3 line 43 to col. 5 line 67);

determining, from the location information, whether the geographic location of the given recipient processor is within a predefined location or region (see at least Figs. 1-4 and associated text; col.1 line 60 to col. 2 line18; col. 3 line 43 to col. 5 line 67):

requiring predefined additional information (implicitly at least the user device ID, which is inherently predefined, is requested by the system: see at least Figs. 1-4 and associated text; col.1 line 60 to col. 2 line18; col. 3 line 43 to col. 5 line 67)

before providing the given recipient processor with access to first information (see at least Figs. 1-4 and associated text; col.1 line 60 to col. 2 line 18; col. 3 line 43 to col. 5 line 67; col. 5 line 62 to col. 6 line 4) in the event that the given recipient processor is determined to be within the predefined location or region.

As to claims 48 and 57, Cohen discloses the methods of claims 40 and 49 and further discloses receiving location information comprises receiving location information by the given recipient processor and determining comprises determining, by the given recipient processor, whether the geographic location of the given recipient processor is within a predefined location or region (see at least Figs 2-4 and associated text ; col.5 line 46 to col. 6 line 4).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 42-44 and 51-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fano.

As to claims 42 and 51,

Fano discloses the methods of claims 40 and 49 but does not specifically disclose the additional information required comprises user age information. However it does disclose querying the user profile (see at least Fig. 13, item 1340 and associated text) in order to provide customized information. Official Notice is taken that it is well-known that consumer profiles comprise age information. It would have been obvious to one skilled in the art at the time the invention was made to add user age information to Fano's teaching of user profiles, in order to further customize information, based on this additional profile factor, the age of the consumer.

As to claims 43 and 52, Fano does not specifically disclose the additional information comprises payment information. However it discloses transaction closing after user location is determined (see at least col. 52 lines 5-8). Official Notice is taken that it is well-known to require some kind of payment information, such as credit card information, in order to conclude a transaction. It would have been obvious to one skilled in the art at the time the invention was made to add requiring payment information to the Fano system, after determining the user location, to allow transaction closing as taught in Fano.

As to claims 44 and 53, Fano does not specifically disclose the additional information comprises a user indication that a waiver, license or disclaimer is accepted. However Official Notice is taken that it is well-known that certain products are sold with warnings or disclaimers.

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For example some online content to be accessed by the user by download to a user device would be preceded by disclaimers as to the appropriateness of the content. Usually user acceptance of the disclaimer is required before the download can proceed. It would have been obvious to one skilled in the art at the time the invention was made to add requiring such acceptance by the user to the Fano teaching of downloading content to the user device, before sending the first information, to ensure the user agrees with the appropriateness of the content before the download.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Glick US 6985588 B1 discloses System and method for using location identity to control access to digital information.

Wall US 20020017977 A1 discloses Method and apparatus for licensing and controlling access, use, and viability of product utilizing geographic position.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KHANH H. LE whose telephone number is 571-272-6721. The Examiner can normally be reached on Monday-Friday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Myhre James can be reached on 571-272-6724. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314).

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

March 27, 2009

/Khanh H. Le/
Examiner, Art Unit 3688

/James W Myhre/
Supervisory Patent Examiner, Art Unit 3688